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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/469,993

12/22/1999

SHERYL BEHAR

003184/0006

5639

31013

7590

05/22/2007

KRAMER LEVIN NAFTALIS & FRANKEL LLP  
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NEW YORK, NY 10036

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 05/22/2007

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notice of Non-Compliant  
Amendment (37 CFR 1.121)**

Application No.

09/469,993

Examiner

Khanh H. Le

Applicant(s)

BEHAR ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 4/20/2007 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
  - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
  - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☒ E. Other: See attached Office Action.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):  
\_\_\_\_\_

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

**TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:**

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a Quayle action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

**Extensions of time** are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action.

**Failure to timely respond** to this notice will result in:

**Abandonment** of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action; or

**Non-entry** of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

\_\_\_\_\_  
Legal Instruments Examiner (LIE), if applicable

\_\_\_\_\_  
Telephone No.

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### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, Applicant's submission filed on 4/20/2007 has been entered. Claims 1-3, 8, 11, 13-17, 19-22, 27, 30, 32-36, 38 and 39 remain pending. Claims 1, 20, 39 are independent.

Independent claims 20 and 39 substantially parallel independent system claim 1 in method formats.

### Restriction by Original Presentation

2. Newly amended independent claims 1, 20, 39 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

**Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06).**

In the instant case, inventions I and II are directed to different inventions :

a) **Invention I is all previous claims.**

**Representative previous independent claim 1 (steps a) , b) etc.. and bold emphasis are added for clarity) read:**

A computerized system for implementing a credit card program **rewarding use of a credit card** by the credit card holder, comprising:

a) a credit card issued by an issuer to a holder, said credit card representing an available line of credit from said issuer for said holder and providing means for said issuer to settle one or more credit card transactions of said holder,

b) a data-processing computer, said computer including a database, said database storing a holder ID and a current balance associated with said holder, said current balance including a sum of all said credit card transactions and any finance or other charges minus any payments by said holder to said issuer and any refunds or other credits,

c) **means associated with said computer for determining whether at least one of said credit card transactions** made by said holder complies with a set of pre-defined program rules, said pre-defined program rules including objective criteria by which said holder is rewarded based on

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the **purchase using said credit card** of at least one of goods and services of any provider of goods or services

regardless of whether there is a co-branding relationship between said issuer and said provider associated with said credit card,

d) a rebate tally for said holder stored in said database, said rebate tally representing rebate credits earned by said holder based on ones of said credit card transactions that comply with said pre-defined program rules less any rebate payments paid by said issuer to said holder, said rebate tally being automatically updated in said database in response to said ones of said credit card transactions that comply with said pre-defined program rules without notice from said holder and said provider, and

e) a rebate payment from said issuer to said holder based on said rebate tally and being provided without affecting any point-of-sale credit card transactions of said holder, said rebate payment being unrestricted by said issuer and said provider as to use by said holder.

Thus Invention I is directed mainly to a system and method for implementing a program **rewarding use of a credit card** by the credit card holder comprising: c) **determining whether at least one of the credit card transactions** made by said holder complies with a set of pre-defined program rules, whereby said pre-defined program rules reward the credit card holder for **purchase transactions made using the card**.

b) **Invention II is all instant pending claims:**

**Representative instant claim 1 reads:**

A computerized system for implementing a credit card program rewarding use of a credit card by the credit card holder, comprising:

a) a credit card issued by an issuer to a holder, said credit card representing an available line of credit from said issuer for said holder and providing means for said issuer to settle one or more credit card transactions of said holder,

b) a data-processing computer, said computer including a database, said database storing a holder ID and a current balance associated with said holder, said current balance including a sum of all said credit card transactions and any finance or other charges minus any payments by said holder to said issuer and any refunds or other credits,

c) **means associated with said computer for determining whether at least one of said credit card transactions** made by said holder complies with a set of pre-defined program rules, said

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pre-defined program rules including objective criteria by which said holder is rewarded based on purchase of at least one of goods and services of any provider of a preselected class of goods or services

regardless of whether there is a co-branding relationship between said issuer and said provider associated with said credit card,

**and regardless of whether the purchase is made using the card**

d) a rebate tally for said holder stored in said database, said rebate tally representing rebate credits earned by said holder based on ones of said credit card transactions that comply with said pre-defined program rules less any rebate payments paid by said issuer to said holder, said rebate tally being automatically updated in said database in response to said ones of said credit card transactions that comply with said pre-defined program rules without notice from said holder and said provider, and

e) a rebate payment from said issuer to said holder based on said rebate tally and being provided without affecting any point-of-sale credit card transactions of said holder, said rebate payment being unrestricted by said issuer and said provider as to use by said holder.

It is interpreted (based on arguments in Applicant(s)' Response page 13, 2nd full paragraph and despite some inconsistencies in the claims) **that Invention II consists mainly of a system and method for implementing a program rewarding the credit card holder, comprising: c) determining whether at least one of the transactions made by said holder complies with a set of pre-defined program rules, whereby said pre-defined program rules reward the credit card holder for purchase transactions made regardless of whether the purchases are made using the card** as long as the purchases are of a preselected class of goods or services.

c) Since invention II does not monitor qualifying purchases to be made on the credit card, its system would be incapable of use together with invention II which requires monitoring that the purchases be made on the credit card before granting rewards.

d) Also, the inventions as claimed have a materially different design, mode of operation, function, or effect such as invention I requires monitoring whether qualifying purchases are made using the credit card while invention II does not so require. As to effect, invention II allows earning rebates without ever making a purchase using the credit card while invention I does not so allow. Thus at least their modes of operations and effects are completely different.

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3. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, all pending claims are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Thus the amendment in effect cancels all claims drawn to the elected invention (Invention I) and presents only claims drawn to a non-elected invention (Invention II) and thus is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention as explained above.

#### *Conclusion*

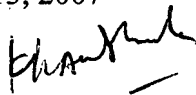
4. Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600.

May 13, 2007

KHL



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